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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,741	12/26/2001	John Tiong-Heng Chuah	53921/187	1635
27871	7590	11/21/2005	EXAMINER	
BLAKE, CASSELS & GRAYDON LLP BOX 25, COMMERCE COURT WEST 199 BAY STREET, SUITE 2800 TORONTO, ON M5L 1A9 CANADA			TON, DANG T	
			ART UNIT	PAPER NUMBER
			2666	

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/025,741

Applicant(s)

CHUAH ET AL.

Examiner

DANG T. TON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/25/04</u> . | 6) <input type="checkbox"/> Other: _____ |

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

2. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 line 10, " said starting point " has no antecedent basis. Similar problems exists in claim 6.

Claims 2-5 and 7-9 are rejected since they depend from claim 1.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or

would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/025,742. Although the conflicting claims are not identical,

they are not patentably distinct from each other because of the following formality:

For claims 1-15, the claims 1-12 of copending Application No. 10/025,742 disclose a method of identifying a failure location in any datapath in a set of datapaths in a communication element, each datapath of the set of datapaths traversing from an ingress point through at least a first component to an egress point, the method comprising: Providing a diagnostic cell to adapted to be inserted at a starting point upstream of the first component in the any datapath; Providing at least a first diagnostic cell counter module adapted to be associated with a first location in the first component, the first diagnostic cell counter module adapted to recognize when the diagnostic cell passes the first location and adapted to track passage of the diagnostic cell past the first location; Inserting the diagnostic cell into the any datapath at the starting point; and Analyzing the diagnostic cell counter module to identify the failure location in the any datapath ;

wherein the ingress point and the egress point reside on a same component in the communication element; the set of

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datapaths is routed from the ingress point to the egress point via a hardware loop-back; and the diagnostic cell counter module tracks passage of the diagnostic cell past the first location using a counter ;

wherein the failure location is identified as being downstream of the first location when the diagnostic cell counter module recognized that the diagnostic cell passed the first location;

wherein a second diagnostic cell counter module is provided at a second location in the datapath, the second diagnostic cell counter module adapted to recognize when the diagnostic cell passes the second location and adapted to track passage of the diagnostic cell past the second location ;

wherein the failure location is identified as being downstream of the second location when the second diagnostic cell counter recognized that the diagnostic cell passed the second location;

wherein the datapath is a VPI/VCI connection;

a system for identifying a failure location in any datapath in a set of datapaths in a communication element, each datapath of

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the set of datapaths traversing from an ingress point through at least a first component to an egress point, the system comprising: at least a first diagnostic cell counter module adapted to be associated with a first location in the first component, the first diagnostic cell counter module adapted to recognize when a diagnostic cell passes the first location and adapted to track passage of the diagnostic cell past the first location; an analysis module adapted to analyze the diagnostic cell counter module to identify the failure location in the any datapath;

wherein the ingress point and the egress point reside on a same component in the communication element; the set of datapaths is routed from the ingress point to the egress point via a hardware loop-back; and the diagnostic cell counter module tracks passage of the diagnostic cell past the first location using a counter;

wherein the analysis module identifies the failure location as being downstream of the first location when the diagnostic cell counter module recognized that the diagnostic cell passed the first location;

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wherein a second diagnostic cell counter module is provided at a second location in the any datapath, the second diagnostic cell counter module being adapted to recognize when the diagnostic cell passes the second location and being adapted to track passage of the diagnostic cell past the second location; and

wherein the analysis module is adapted to identify the failure location as being downstream of the second location when the second diagnostic cell counter recognized that the diagnostic cell passed the second location .

NOTE: See claims 1-12 of copending Application No. 10/025,742.

Applicant's claims 1-15 merely broaden the scope of the claims 1-12 of copending Application No. 10/025,742 by eliminating the terms " any data path in a set of data paths" from claim 1 and 7 of the claims 1-12 of copending Application No. 10/025,742. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd.

App. 1969); omission of a reference element whose function is not need would be obvious to one skilled in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Moll (EP 0777401).

Note: the term " adapted to" recited in claims are not positive limitation. Therefor the limitation following the term is not considered the claimed limitation. It is suggested applicant to remove the term from the claims.

For claims 1 and 10, Moll disclose a method/system for controlling a loop back test between points comprising Providing a diagnostic cell (see column 3 lines 25-37) ; Providing at least a first diagnostic cell counter module(see column 3 lines 25-37); Inserting the diagnostic cell into the data path at the starting point(see column 3 lines 25-31); and Analyzing the diagnostic cell counter module to identify the failure location in the data path(see column 3 lines 25-31 and lines 54-56).

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2,3,11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moll in view of Norizuki et al. (5,357,510).

For Claims 2,3,11, and 12, Moll discloses all the subject matter of the claimed invention with the exception of tracking message of the diagnostic cell past the location by using a counter in a communications network. Norizuki et al. from the same or similar fields of endeavor teaches a provision of tracking message of the diagnostic cell past the location by using a counter (see box 102 in figure 8). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to use tracking message of the diagnostic

cell past the location by using a counter as taught by Norizuki et al. in the communications network of Moll.

The tracking message of the diagnostic cell past the location by using a counter can be implemented/modified into the network of Moll Gibson by connecting the counter in the ATM switch. The motivation for tracking message of the diagnostic cell past the location by using a counter as taught by Norizuki et al. into the communications network of Moll being that it prevents congestion and make the system more reliable.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Munter (5,144,619) is cited to show a system which is considered pertinent to the claimed invention.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANG T. TON whose telephone number is 571-272-3171. The examiner can normally be reached on MON-WED, 5:30 AM-6:00 PM and Thur 5:30-9:30 A.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RAO SEEMA can be reached on 571-272-3174. The fax phone number for the

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organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Ton



DANG TON
PRIMARY EXAMINER